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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,320	09/10/2004	Hideki Kitano	Q83497	4421
23373 7590 03/17/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER VERDERAME, ANNA L.	
			ART UNIT 1795	PAPER NUMBER
			MAIL DATE 03/17/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/507,320

**Applicant(s)**

KITANO ET AL.

**Examiner**

ANNA L. VERDERAME

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-9 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-9 and 25-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The finality of the office action mailed on 11/09/2007 is withdrawn. New rejections are presented below.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-9, and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuoka et al. JP-11102542 in view of. Nagamato et al. 6,723,619.

Matsuoka et al. teaches a laminate consisting of a release sheet and a second release sheet bonded to each other with a double sided adhesive sheet. A first disc substrate and a second disc substrate (16a and 16b) are prepared. The first release sheet is peeled off from the laminate and the 1st disc substrate 16a is bonded to the exposed adhesive surface of the double-sided adhesive sheet. Then the second release sheet is peeled off from the surface of the double-sided adhesive sheet opposite to the surface to which the 1st disc substrate 16a is bonded and the 2nd disc substrate 16b is bonded to the exposed adhesive surface of the double-sided adhesive sheet 11(abstract). The use of exfoliation sheets (release sheets) made from polyethylene, polyester, and polypropylene is disclosed at (0018). Benefits of using a double-sided adhesive sheet include reduced distortion and more precision in the thickness of the layer (0039-0041).

Nagamoto et al. teaches a pressure sensitive adhesive sheet for semiconductor wafer processing. A substrate made of polyolefin, or polypropylene (6/49-56), the thickness of the adhesive is 1-100 micrometers and preferably 5-50 micrometers, and a release liner may be applied to the UV-curable pressure sensitive adhesive composition in order to protect the same(7/20-27). Ultraviolet curable polymer according to this application is disclosed at(1/60-3/18). Properties are disclosed at (4/18-4/28). Use of photopolymerization initiators in the amount of 0.005 to 20 parts by weight is disclosed at (5/52-57). A cross-linking agent may be added(6/12-34). See also disclosure at (5/14-31).

See comparative example 1 in table 1, where A is an ultraviolet curable copolymer as described at (8/65-9/4), and 1-hydroxycyclohexyl phenyl ketone is used as a photopolymerization initiator.

With regard to surface roughness and light-transmittance in the range of 380-420nm of the photo-curable adhesive, the applicant has the burden of showing that a pressure sensitive UV-curable adhesive as taught in comparative example 2 does not possess these properties.

It would have been obvious to one of ordinary skill in the art to form the adhesive layer taught by Matsuoka et al. of an photopolymerizable pressure sensitive adhesive composition like that taught in comparative example 1 of Nagamoto et al. and having a thickness of from 1-100 micrometers and more preferably from 5-50 micrometers based on the general teachings of adhesives

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by Matsuoka and based on the disclosure in Nagamoto et al. to form adhesive layers having a thickness of from 1-100 micrometers and more preferably from 5-50 micrometers on to a substrate of for example polyolefin or polypropylene and to optionally provide a release layer on the adhesive layer in Nagamoto et al. at (6/49-56) and (7/20-27).

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5-7, 9 and 25-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 23 of copending Application No. 10/574,840. Although the conflicting claims are not identical, they are not patentably distinct from each other because Applicant discloses that a transfer sheet and an adhesive sheet are basically equivalent in the specification

at (0106) and (0105). In regard to the properties recited in instant claims 1-3 and 25-28, the photo-curable composition recited in application No. 10/574,840 are believed to embrace compositions having properties recited in the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-US 2002/0176997-see disclosure at (0097-0099).

2-isocyanatoethylmethacrylate is listed as an example of a suitable coupling compound at (0102).

-US 5,462,797 –see claim 17

-JP-63186722- see abstract

- JP-60-38403-see abstract

-US-5,916,738 –see synthesis example 1

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNA L. VERDERAME whose telephone number is (571)272-6420. The examiner can normally be reached on M-F 8A-4:30P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (571)272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. L. V./

Examiner, Art Unit 1795

**/Mark F. Huff/**

**Supervisory Patent Examiner, Art Unit 1795**